

ATTORNEY DOCKET
064198.0171PATENT APPLICATION
10/633,356

6

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed May 4, 2005. At the time of the Office Action, Claims 1-20 were pending in this Application. Claims 1-20 were rejected. Claims 1, 2, 8, 11, and 20 have been amended to advance prosecution of this Application. Applicants respectfully request reconsideration and favorable action in this case.

Claims 1-19 are Allowable over the proposed *Uppaluru-Enzmann* combination.

Claims 1-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,915,001 issued to Premkumar V. Uppaluru ("Uppaluru") in view of U.S. Patent No. 6,320,946 issued to Mark J. Enzmann et al. ("Enzmann"). Applicants respectfully traverse and submit that the proposed *Uppaluru-Enzmann* combination, even if proper (which Applicants do not concede) does not render the claimed embodiment of the invention obvious, for at least the reasons discussed below.

A. The proposed *Uppaluru-Enzmann* combination fails to teach or suggest all of the limitations of amended Claims 1-19.

The Examiner's proposed combination of *Uppaluru* and *Enzmann* fails to teach or suggest all of the limitations of amended Claims 1-19.

For example, amended independent Claim 1 recites:

A method of providing a user with access to the content of an Internet portal, using the public switched telephone network (PSTN) and a modemless connection, comprising the steps of:

receiving, at an interactive voice response (IVR) system, a telephone call from the user, dialed with a calling card number and incoming through the PSTN;

recognizing IVR input from the user to select between a voice call and modemless Internet portal access;

for a voice call, completing the telephone call to a destination telephone number; and

for modemless Internet portal access, performing the following steps: receiving IVR input from the user representing a password; providing the user with a preference selection menu; providing the user with a content selection menu; receiving IVR input from the user representing Internet content

ATTORNEY DOCKET
064198.0171PATENT APPLICATION
10/633,356

7

selection; communicating the content selection to an Internet server via modemless communications; translating the Internet content from text format to audio data; and transmitting the audio data to the user via the PSTN.

Uppaluru and *Enzmann*, whether considered alone or in combination, fail to teach or suggest at least the following limitations of amended Claim 1:

- “recognizing IVR input from the user to select between a voice call and modemless Internet portal access” (emphasis added)
- “for modemless Internet portal access, performing the following steps: receiving IVR input from the user representing a password; providing the user with a preference selection menu; providing the user with a content selection menu; receiving IVR input from the user representing Internet content selection; communicating the content selection to an Internet server via modemless communications; translating the Internet content from text format to audio data; and transmitting the audio data to the user via the PSTN. (emphasis added)

The Examiner acknowledges that “*Uppaluru* does not specifically teach recognizing input from the user to select between a voice call and Internet portal access.” (Office Action, page 4). However, the Examiner alleges that “*Enzmann* teaches recognizing input from the user to select between a voice call and Internet portal access and for a voice call, completing the telephone call to a destination telephone number, (Abstract; col. 2, lines 6-17; col. 10, lines 23-39).” (Office Action, page 4).

However, *Enzmann* does not teach or suggest providing a user modemless Internet portal access, much less a selection between a voice call and modemless Internet portal access. Rather, *Enzmann* teaches a payphone that allows a user to make a telephone call or obtain information stored in the payphone, where such information is periodically updated from an external server or the Internet via a modem 56. (see Abstract; Figs. 2-3; col. 9, line 43 - col. 10, line 9). Thus, *Enzmann* teaches directly away from providing a user modemless Internet access. Accordingly, *Enzmann* also fails to teach or suggest “communicating [a user] content selection to an Internet server via modemless communications,” as recited in amended Claim 1.

AUS01:382865.1

ATTORNEY DOCKET
064198.0171PATENT APPLICATION
10/633,356

8

For at least these reasons, Applicants respectfully request reconsideration and allowance of amended independent Claim 1. In addition, for analogous reasons, Applicants respectfully request reconsideration and allowance of independent Claims 2 and 11, together with Claims 3-10 and 12-19 that depend therefrom.

B. The proposed combination of *Uppaluru* and *Enzmann* is improper.

Even assuming for the sake of argument that the proposed *Uppaluru-Enzmann* combination did disclose, teach or suggest the combination of limitations recited in Claims 1-19 (which Applicants do not agree), the proposed *Uppaluru-Enzmann* combination is improper. In particular, the Examiner has not shown the required suggestion or motivation to combine *Uppaluru* with *Enzmann*.

To establish a *prima facie* case of obviousness, the Examiner must show, among other things, some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2142. (emphasis added)

Regarding the proposed combination of *Uppaluru* with *Enzmann*, the Examiner merely states:

“Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the system of *Uppaluru* by providing access to telephony calls with the calling card so that the user can access both Internet and regular calls via the same access card. This will also simply [sic] billing since the user is charged for both services under one account.” (Office Action, pages 4-5).

Thus, the Examiner merely asserts that combining *Uppaluru* with *Enzmann* would provide particular advantages. However, such reasoning fails to meet the requirement for combining references, as set out in the M.P.E.P. In particular, the Examiner presents no suggestion or motivation in either *Uppaluru* or *Enzmann* to combine the two references. See M.P.E.P. §§ 2142 and 2143.01.¹ According to the M.P.E.P., “[t]he mere fact that references

¹ If the Examiner is relying on “common knowledge” or “well known” art in support of his rationale for combining the references, the Examiner is requested to produce a reference in support of his position pursuant to M.P.E.P. § 2144.03. If the Examiner is relying on personal knowledge to supply the required motivation or

ATTORNEY DOCKET
064198.0171PATENT APPLICATION
10/633,356

9

can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143.01. (emphasis added).

Applicants thus assume that the Examiner's assertion that the proposed combination "would have been obvious" is based merely on speculation in hindsight, which is insufficient for supporting a modification or combination of references, under both the M.P.E.P.² and governing Federal Circuit case law.³

For at least these reasons, Applicants respectfully submit that the proposed combination of *Uppaluru* with *Enzmann* is improper, and thus request the Examiner withdraw the rejections of Claims 1-20 under 35 U.S.C. §103(a).

suggestion to combine, Applicants respectfully request that the Examiner produce an affidavit supporting such facts pursuant to M.P.E.P. § 2144.03.

² See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.)

³ For example, in *In re Dembiczaik*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).

AUS01:382865.1

ATTORNEY DOCKET
064198.0171PATENT APPLICATION
10/633,356

10

Claim 20 is Allowable over Uppaluru.

Claim 20 was rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by *Uppaluru*." Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

Amended independent Claim 20 recites:

A method of providing a user with access to an Internet portal having associated content, comprising the steps of:

providing the user with access to the Internet portal via an Internet link provided at a computer;

providing the user with modemless access to the Internet portal content via a calling card number communicated from a telephone over the public switched telephone network (PSTN);

providing means for receiving user input representing preference selections via the Internet link provided at the computer; and

providing means for receiving user input representing preference selections via a calling card call on the PSTN made using the telephone.

Uppaluru does not teach or suggest providing a user access to an Internet portal or Internet portal content from both (a) a computer, via an Internet link, and (b) a telephone, via a modemless link. Further, *Uppaluru* does not teach or suggest providing a user means for receiving user input regarding preference selections via both (a) a computer, via an Internet link, and (b) a telephone.

Rather, *Uppaluru* merely teaches providing a user access to a "voice web" or "voice web pages" via a telephone connected to the Internet. Nowhere does *Uppaluru* teach providing a user access to the same Internet content from both a computer (via an Internet link) and a telephone (via a modemless link). Moreover, nowhere does *Uppaluru* teach providing a user means for receiving user input regarding preference selections via both (a) a computer and (b) a telephone.

Thus, *Uppaluru* fails to teach or suggest the limitations of amended Claim 20. For at least these reasons, Applicants respectfully request reconsideration and allowance of amended independent Claim 20.

AUS01:382865.1

ATTORNEY DOCKET
064198.0171

PATENT APPLICATION
10/633,356

11

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of Claims 1-20 as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2689.

Respectfully submitted,
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Date: August 4, 2005

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AUS01:382865.1